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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/835,885 | 04/16/2001 | Ari Uistola | 872.7588USX | 4677 |

29683 7590 11/22/2004

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| EXAMINER |
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MEHRPOUR, NAGHMEH

| ART UNIT | PAPER NUMBER |
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2686

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,885

Applicant(s)

UISTOLA

Examiner

Naghmeh Mehrpour

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-20, are rejected under 35 U.S.C. 102(b) as being anticipated by Hicks (US Patent Number 6026300).

Regarding Claims 1, 5, 9, 12, 16-17, 20, Hicks teaches a method for operating a mobile station, comprising steps of:

(a) storing information in a memory of the mobile station, the stored information comprising an ordered list of frequency bands, each frequency band comprising at least one channel, the stored information further comprising an identity of a band wherein an acceptable control channel was last located (col 3 lines 45-55);

(b) in response to a user invoking a search procedure to locate a new non-public system, accessing the memory to determine the identity of the band wherein an acceptable control channel was last located, and marking the band wherein the acceptable control channel was last located as a band to be searched (col 3 lines 56-65);

(c) collecting signal strength measurements on channels in the band to be searched and executing a channel search procedure to locate a control channel

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of a desired non-public system within the band to be searched (col 3 lines 45-65);

(d) if a desired non-public system is not located in the band to be searched, accessing the memory to obtain a next band to be searched from the ordered list of frequency bands and marking the next band as the band to be searched; and repeating steps (c) and (d) until either the ordered list of frequency bands is exhausted or a desired non-public system is located (col 3 lines 65-67, col 4 lines 1-10).

Regarding Claims 2, 10, Hicks teaches a method wherein the desired non-public system is one of a Residential system or a Private system (col 1 lines 35-48).

Regarding Claims 3, 11, Hicks teaches a method wherein the control channel is a digital control channel (DCCH) (col 4 lines 1-5).

Regarding Claims 4, 12, 18, Hicks teaches a method wherein at least one frequency band is an 800 MHz frequency band (analog), and wherein at least one other frequency band is a 1900 MHz frequency band (digital) (col 4 lines 1-10, col 8 lines 1-8).

Regarding Claims 5, 13, Hicks teaches a method wherein if the step of accessing the memory to determine the identity of the band wherein an acceptable control channel was last located is not successful, the method instead includes a step of accessing the memory to obtain a predetermined band to be searched from the ordered list of frequency bands and marking the

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predetermined band as the band to be searched (col 4 lines 1-10, col 7 lines 59-67, col 8 lines 20).

Regarding Claims 6, 14, Hicks teaches a method wherein the predetermined band (digital) is the first band in the ordered list of frequency bands (col 8 lines 1-20).

Regarding Claims 8, 16, 20, Hicks teaches a method wherein the step of storing information is accomplished by receiving the information over the air from a remote location (col 2 lines 15-27).

Regarding Claim 19, Hicks teaches a method wherein the step of storing information includes a step of inputting information for at least one of adding an entry to the list, deleting an entry from the list, or re-ordering entries in the list (col 7 lines 5-10, lines 45-50).

Response to Arguments

3. Applicant's arguments with respect to claims 1-20, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tai et al. (US Patent Number 5,825,757) disclose method and apparatus for excluding communication channels in a radio

5. **Any responses to this action should be mailed to:**

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 703-308-7159.

The examiner can normally be reached on 8:00- 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold be reached (703) 305-4379.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NM

November 1, 2004

WELCOMMEHROUP
PATENT EXAMINER
